REMARKS

Review and reconsideration of the present application is respectfully requested in view of the above amendments and the following remarks.

In this Office Action, the Examiner has rejected claims 1 and 3 under 35 U.S.C. §102(b) as anticipated by Olsen et al. (US 4,688,998); has rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over '998 and Giardini et al. (US 3,932,069); has rejected claims 1 and 3-4 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-3 of prior U.S. Patent No. 5,947,394; and has rejected claims 2, 5, 7, 13-14, 16, 18, 20, 22 and 28-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 6-7 of '394 in view of '069. Lastly, Examiner has indicated that claims 34-49 are allowable.

Applicants are grateful for the Examiner's kind allowance of claims 34-49. In light of the Office Action, applicants have cancelled claims 1-3 and have filed with this response a terminal disclaimer (enclosed) in compliance with 37 CFR 1.321(c) to overcome Examiner's claim rejections based on nonstatutory double patenting grounds.

Specifically with respect to Examiner's rejection of independent claim 4 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-3 of prior U.S. Patent No. 5,947,394, applicants are of the opinion that claim 4 fails to claim the same invention as recited in claims 1-3 of '394. As such, the statutory double patenting rejection of claim 4 is believed to be without merit.

To reject a claim in an application over an issued patent based on double patenting, one must determine whether the same invention is being claimed twice. "Same invention" has been determined to mean identical subject matter. For example, the invention defined by a claim reciting "halogen" is not the same as that defined by a claim reciting "chlorine," because the former is broader than the latter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467 (CCPA 1957); *In re Vogel*, 422 F.2d 438 (CCPA 1970); and MPEP §804.

By way of further example, in *In re Vogel*, as cited above, appellants filed a patent application for a process of preparing packaged meat products for prolonged storage. The claims were rejected as involving same invention type double patenting based on appellants' existing patent involving a process for preparing pork for storage. On appeal, the court determined that the same invention was not being claimed twice because the patent claims were limited to pork while the appealed claims were limited to meat, which is not the same thing.

In light of the above, a comparison of claim 4 with claims 1-3 in '394 indicates that claim 4, in fact, is not drawn to subject matter that is identical to claims 1-3 of the '394 patent. Accordingly, applicants earnestly contend that the statutory double patenting rejection of claim 4 is improper.

Lastly, applicants have filed, under separate cover, a Recordation Form Cover Sheet and copy of certified Certificate of Amendment to record the name change of Applicant from Thermo Black Clawson Inc. to Kadant Black Clawson Inc. (copy enclosed).

Accordingly, it is respectfully submitted that all of the solicited claims are in proper form for allowance. The prompt issuance of a Notice of Allowance is accordingly solicited.

The Examiner is requested to telephone the undersigned if any question or comment should arise during consideration of this matter.

Respectfully submitted,
BIEBEL & FRENCH

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